

REMARKS

STATUS OF CLAIMS

Claims 1-4, 7-24 and 27-36 are pending in the application. Claims 1 and 21, the independent claims, have been amended herein.

Section 101 Rejection

Claims 1-20 (this is a typographical error in the Action – claims 5, 6, 25 and 26 were previously canceled) were rejected under 35 USC 101 as directed toward non-statutory subject matter. The Action states that the claim language “does not transform the underlying subject matter and the process is not tied to another statutory class”. Applicant respectfully traverses this rejection, and notes that each of independent Claims 1 and 21 involves “processing a digital image”, and as currently amended, recites ‘transferring the digital image onto a second physical medium’, and ‘manually providing a photofinishing product to the user’, the product including the second physical medium. These claims are believed to fully comply with the requirements of Section 101 based upon Supreme Court precedent and recent Federal Circuit decisions. Reconsideration and withdrawal of the Section 101 rejection are accordingly requested.

Section 112, second paragraph Rejection

Claims 1-4, 7-24 and 27-36 were rejected under 35 USC 112, second paragraph, as being indefinite. Each of the issues noted in the Action with regard to Claim 1 (steps (b) and (d)) and Claim 21, has been addressed in the foregoing claim amendments. Therefore, reconsideration and withdrawal of the Section 112 rejection is respectfully requested.

Section 102(e) Rejection

Claims 1-36 (again, Claims 5, 6, 25 and 26 were previously canceled, leaving only Claims 1-4, 7-24 and 27-36 under consideration) were rejected under 35 USC 102(e) as being anticipated by US Patent 6,915,273 (Parulski). In view of the foregoing claim amendments and the following discussion, this rejection is respectfully traversed and reconsideration is requested.

Each of independent Claims 1 and 21 has been amended to now include a positive recitation of “*transferring the digital image onto the second physical medium*” – and *manually providing* a photofinishing product to the user in accordance with the specified package, wherein the package of photofinishing products includes the second physical medium.

Parulski fails to teach or suggest a method for processing a digital image in accordance with Applicant’s independent Claims 1 and 21 – and in particular, fails to teach or suggest *transferring the digital image onto the second physical medium, and manually providing* a photofinishing product to the user in accordance with the specified package, wherein the package of photofinishing products includes the second physical medium.

With regard to dependent Claim 7, which recites that the “second physical medium is a CD-ROM”, the Action directs Applicant to col. 4, lines 61-63 of Parulski citing “...input digital image from a CD-ROM disc; col. 4, lines 61-63). Again -- Applicant respectfully notes that Parulski does not, in any way, teach or suggest a method for processing a digital image, that includes “transferring a digital image onto a CD-ROM” and providing the CD-ROM to the user in accordance with the specified package.

Rather, the section noted at col. 4, simply states that the CPU motherboard 82 (of retail kiosk 80) “communicates with a CD reader 92....[which] can be used to input digital images from a CD-R disc, such as a Kodak Picture CD”. This teaches *only a reader to input images from a CD-R disc* – which does not teach or suggest *providing a package, to a user, that includes a second physical medium onto which the digital image has been transferred*.

For at least the foregoing reasons, Applicants respectfully submit that each of amended independent Claims 1 and 21 is patentable over Parulski.

Dependent Claims 2-4, 7-20, 22-4 and 27-36 are also believed to be clearly patentable over the art of record for all of the reasons indicated above with respect to Claims 1 and 21, one or the other from which they depend, and even further distinguish over the cited references by reciting additional limitations.